REMARKS

First, the Applicant wishes to thank the Examiner for his exceptional courteousness in the handling of this case.

With respect to the drawings, the Examiner issued an Office Action on August 30, 2002 in which he indicated that "the drawings submitted on February 2002 are accepted." The Applicant, however, has respectfully submitted a set of more formal drawings as replacement sheets. No new matter has been added.

The Examiner has indicated that the information disclosure statement filed January 12, 2004 cannot be considered because it was after the mailing of a final rejection and not accompanied by the requisite petition and fee. On May 20, 2004, the Applicant resubmitted the same information disclosure statement with the requisite fee and petition. Therefore, the Applicant submits that the information disclosure statement filed on May 20, 2004 is condition for full consideration.

The Examiner has rejected Claims 1, 5-8, and 15-17 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Pat. No. 3,921,620 to Nakayama ("Nakayama"). The Applicant respectfully traverses the rejection.

In light of the newly amended Claim 1, Nakayama fails to anticipate the claimed invention. Specifically, Nakayama fails to disclose an improved holder for mounting on a liquid containing device. Indeed, Nakayama does not disclose a holder at all, let alone one that can be mounted on a liquid containing device such as a beverage can or bottle. Further, Nakayama does not disclose a holder for mounting on a beverage container having a magnetic means therein

wherein said magnetic means comprises at least one magnet having the strength of about or greater than 30 kilogauss. Nakayama only discloses the use of low magnetic force. The highest magnetic force that Nakayama discloses in his experiments is 850 gauss, which is equivalent to 0.850 gauss – far less than the claimed "about or greater than 30 kilogauss."

Accordingly, Nakayama does not anticipate Claim 1, or Claims 5-8 and 15-17, all of which depend from Claim 1. Therefore, the Applicant respectfully submits that the rejection of Claims 1, 5-8, and 15-17 is overcome, and withdrawal thereof is respectfully requested.

The Examiner has rejected Claims 2, 9, and 11 under 35 U.S.C. 103(a) as allegedly being unpatentable over Nakayama. The Examiner has specifically alleged that the type of magnet used is considered to be a matter of engineering choice with no patentable significance.

Claim 2 has been incorporated into Claim 1, and Claims 9 and 11 depend from Claim 1. Therefore, the Applicant will address the rejection in light of newly amended Claim 1.

First and respectfully, Nakayama is nonanalogous art. With respect the nonanalogousness of the references, the relevant test for determining whether particular references are appropriate and analogous is to 1) determine whether the references are "within the field of the inventor's endeavor"; and 2) assuming the references are outside that field, to determine whether the references are "reasonably pertinent to the particular problem with which the inventor was involved." In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); see also In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992). The Federal Court cautions that in determining the appropriateness of applying a reference, "prior art may not be gathered

with the claimed invention in mind." Pentec, Inc. v Graphic Controls Corp., 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985).

Applying the first prong of the test, it is clear that the Nakayama reference is not within the field of the inventor's endeavor. Nakayama is a medical treatment device for efficiently causing magnetic flux to act on the body. Col. 1, lines 5-8. In contrast, the field of the Applicant's endeavor is securing objects, particularly beverage containers, to magnetic surfaces.

Turing to the second prong of the test, it is also clear that Nakayama was not reasonably pertinent to the particular problem the inventor of the present invention was involved. That is, the inventor of the present invention was concerned with the problem of inadequate attachment mechanisms for attaching, among other things, beverage containers to surfaces. Quite to the contrary, Nakayama was directed to solving the problem of low flux density in magnetic medical treatment devices. See Nakayama, Col. 1, lines 32-40. Therefore, Nakayama cannot support a rejection of 35 U.S.C. 103(a) since Nakayama is nonanalogous art.

Even if Nakayama were analogous art, there is no suggestion or motivation to in Nakayama to modify the medical treatment device disclosed in Nakayama to arrive at the claimed improved beverage holder. Nakayama utilizes magnets having a strength less than that of the common magnet. Indeed, the strongest force Nakayama discloses is in Table 1 of the Nakayama reference and is over thirty times less than the force claimed in the present invention. This is because Nakayama is directed a medical treatment device and does not contemplate securing a beverage to a magnetic surface as the claimed invention does. In contrast to Nakayama, the claimed invention utilizes a magnetic force of 30 kilogauss. This is because the

invention requires the use of magnets having strengths more than the strength of commonly known magnets, which as disclosed by the inventor of the present invention is 2.0 to 4.3 kilogauss. See Specification, p. 16, lines 16-27. Therefore, the skilled artisan would not use the teachings of Nakayama, i.e., low magnetic force, to arrive at a holder for a liquid containing device having a magnetic means with a magnetic strength about or above 30 kilogauss.

Nakayama therefore teaches away from the claimed invention by using an magnetic strength stronger than the average magnet. This results from the fact that Nakayama was not at all concerned with securing beverage containers to magnetic surfaces, but was rather concerned with creating a weaker magnetic field optimal for medical treatment. Nakayama clearly states "The use of low magnetic force magnet having the ferromagnetic metal plate applied to one side thereof will have a high efficiency." Nakayama, Col. 8, 36-38.

Accordingly, the rejection under 35 U.S.C. 103(a) of Claims 2, 9 and 11 is overcome and withdrawal is respectfully requested.

The Examiner has also cited U.S. Patent no. 5,782,743 to Russell ("Russell") as pertinent to Applicant's disclosure. The Applicant respectfully submits that the arguments of above equally apply to Russell.

Applicant would appreciate the courtesy of a telephone call should the Examiner have any questions or comments with respect to this response or the claim language for purposes of efficiently resolving same.

Respectfully submitted,

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